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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,149	06/30/2006	Christopher Robert Bebbington	073678-0026	9929
31824 7590 12/30/2010 MCDERMOTT WILL & EMERY LLP 600 13th Street, NW Washington, DC 20005-3096				
EXAMINER				
QIAN, CELINE X				
ART UNIT		PAPER NUMBER		
1636				
NOTIFICATION DATE		DELIVERY MODE		
12/30/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mweipdocket@mwe.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/585,149

Applicant(s)

BEBBINGTON ET AL.

Examiner

CELINE X. QIAN

Art Unit

1636

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 15 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 56-64, 93, 100, 103-106 and 110-117.

Claim(s) withdrawn from consideration: 65-72, 74, 78, 80-92, 94-99, 101, 102 and 107-109.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Celine X Qian /
Primary Examiner, Art Unit 1636

Continuation of 11. does NOT place the application in condition for allowance because: the argument directed to 103 rejection is not persuasive. As set forth in the previous office action, the examiner would like to point out that the decision of Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc. does not apply to the instant case because the factual basis are different between the decision and current application. The Federal decision reached the conclusion of non-obviousness based on the construction of the term "wound" which is defined by that specification being exclusively skin wound, not other types of injury taught by the prior art. In the instant case, the teaching of the specification does not render the combined teaching of prior art non-obvious because the specification does not provide a limiting definition for such level of expression or set forth a range for the expression level. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, Reff has demonstrated that increased production of a polypeptide of interest as a result of expressing the anti-apoptotic protein, which indicate that even high level of expression of the transactivator which may normally be toxic to the cell can be protected from such toxicity with the co-expression of an anti-apoptotic protein. The teaching of Rao reinforces this notion. As such, it is different from the Federal Circuit's decision in *Eisai* and Kinetic Concepts, in which the advantageous property is result from the dropping of the fluorinated substituent. In the instant case, it would have been obvious to an ordinary skill in the art to recognize that the high toxicity results from the expression of a transactivator can be negated by the expression of anti-apoptotic agents based on the teaching of Reff and Rao, therefore, one may use a strong promoter instead of weak promoter to direct the expression of the transactivator. Therefore, for reason discussed in the previous office action and above, this rejection is maintained. The argument directed to the 112 1st paragraph rejection has been considered and deemed persuasive. The new matter rejection is thus withdrawn.